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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,307	03/25/2004	Robert A. Fee	02100.0077	5503
22852	7590	11/02/2005	EXAMINER	
FINNEMAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			GEHMAN, BRYON P	
		ART UNIT		PAPER NUMBER
				3728

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/808,307	FEE, ROBERT A.
<b>Examiner</b>	<b>Art Unit</b>	
	Bryon P. Gehman	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 03 May 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-37 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-18 and 20-37 is/are rejected.  
7)  Claim(s) 19 is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/3/05.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 23-29 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 23, line 1, "with an articles" is ungrammatical and indefinite.

In claim 29, line 1, "clam" is incorrect.

In claim 34, line 2, "wherein flap portion" does not make sense as to grammar.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 8, 11-12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Gartshore et al. (4,103,821). Claims 1-3, 8, 11-12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Broudy (2,214,011) Each discloses a system for associating documents with articles in a shipping container, the system comprising an envelope (10; 1; respectively) with an open end (44; before closing) and first and second overlapping flap portions (20 and 32; envelope closure flap and 2) and having oppositely facing exterior surfaces, a shipping container (12; 9) having a main

body (top of Figure 1; 9 absent flaps 10, 10) and at least one cover portion (side of Figure 1; 10), the envelope being receivable and the flaps affixable to the shipping container. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As to claims 2 and 3, each discloses each of the flap portions having an adhesive layer (34, 38; at the envelope flap and on 2, see page 2, lines 7-29), one of the flap portions contacting the exterior surface of the container.

As to claim 8, each discloses the shipping container to be a box.

5. Claims 16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Timms (3,330,471). Claims 16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Timms (3,250,385). Each discloses a method for associating documents with a shipping container, the method comprising placing an envelope (17; 26 or 26a or 26b; respectively) beneath a cover portion (16; cover sheet of 20) with an open end (at 127; at 33 or 33a or 34) accessible at a side of the cover portion, and affixing a flap portion (33; 28 or at 33a or 34b) to the exterior surface of the main body of a shipping

container (Figure 8; Figure 6) to secure the envelope against removal from the container.

As to claim 21, a document is disclosed as associated with the envelope.

6. Claims 23-24 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Gartshore et al. Disclosed is an envelope comprising a body portion having an open end (at 44) and an exterior surface, at least one flap portion (32) formed at the open end, the at least one flap portion having an exterior surface continuous with the exterior surface of the body portion, and an adhesive layer (34) formed on the exterior surface of the at least one flap portion. Again, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As to claim 24, the body portion includes a front panel (14) and a rear panel (20).

As to claim 28, first and second flap portions (32 and 20 covered by 32) are disclosed.

As to claim 29, Figure 5 shows the flaps having different shapes.

Claims 30-31, 34 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Broudy. Disclosed is a container (9) and a cover portion (10), an envelope comprising a body portion (1) contained within the container, and a flap portion (2) extending from the body portion and attached to the exterior surface of the container.

As to claim 31, the envelope is disposed within the container and adjacent the cover portion.

As to claim 34, disclosed is the flap portion having an adhesive layer (at the flap portion, see page 2, lines 7-29).

As to claim 37, the envelope is disclosed to contain documents.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broudy in view of Knoll et al. (3,155,234). Knoll et al. disclose a container provided with an envelope with the envelope affixed to a main body (at 22) of the container and affixed to a cover portion (at 10). To modify the container of Broudy employing a disposition of the envelope as disclosed by Knoll et al. would have been obvious in order to provide indicia in two dimensions to better locate the envelope and its contents.

Claims 7 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broudy in view of Zudal (6,290,126). Zudal discloses a container (10) similar to Broudy's container, and including end flaps or end flap portions (at folds 32 and 34) which are overlapped by cover portions (14, 16). To modify the container of Broudy employing end flaps as disclosed by Zudal would have been obvious in order to better enclose the top wall of the container.

7. Claims 9-10, 13-14, 25-27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gartshore et al. or Broudy as applied to claims 1, 11, 23 and 30 above, and further in view of Knoll et al (3,155,234). Knoll et al. disclose a shipping document envelope provided with indicator marks (16 and 18) to provide information and to indicate the opening of the envelope. To modify the flap portions of either one of Gartshore et al. and Broudy employing indicator marks as disclosed by Knoll et al. would have been obvious in order to provide instruction relative to use of the envelope, as suggested by Knoll et al..

As to claim 10, Knoll et al. disclose indicator marks (an arrow) that points.

8. Claims 16-18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broudy in view of Timms ('385). Broudy discloses a method for associating documents with a shipping container, the method comprising placing an envelope (1) beneath a cover portion (10), and affixing a flap portion (2) to the exterior surface of the

main body of a shipping container (9) to secure the envelope against removal from the container. Timms discloses a shipping document envelope provided with an open end (at 33 or 33a or 34) when secured to the shipping container. To modify the envelope structure of Broudy employing the open end teaching of Timms would have been obvious in order to allow easier access to the contents of the envelope.

As to claim 17, the flap portion (2) of Broudy includes adhesive (see page 2, lines 7-17).

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 16 above, and further in view of Zudal. Zudal discloses a container (10) similar to Broudy's container, and including end flaps or end flap portions (at folds 32 and 34) which are overlapped by cover portions (14, 16). To modify the container of Broudy employing end flaps as disclosed by Zudal would have been obvious in order to better enclose the top wall of the container.

As to claim 21, a document is disclosed as associated with the envelope.

10. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bryon P. Gehman  
Primary Examiner  
Art Unit 3728

BPG